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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/898,216	07/02/2001	Jennifer L. Hillman	PF-0181-2 CON	3495

27904            7590            09/23/2002  
INCYTE GENOMICS, INC.  
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PALO ALTO, CA 94304

EXAMINER
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YAEN, CHRISTOPHER H

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 09/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/898,216	HILLMAN ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Christopher H Yaen	1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 02 July 2001.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) \_\_\_\_\_ is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) 1-45 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-2, 17-18, drawn to an isolated polypeptide, classified in class 530, subclass 350.
  - II. Claims 3-8, 12-13, drawn to an isolated polynucleotide, transformed cells, a transgenic animal, , classified in class 536, subclass 23.1, for example.
  - III. Claims 9-10, drawn to a method of producing a polypeptide, classified in class 435, subclass 70.1.
  - IV. Claims 11,31-32,34,37-38, and 40-43, drawn to an antibody, classified in class 530, subclass 387.1.
  - V. Claims 14-16, drawn to a method of detecting a target polynucleotide, classified in class 435, subclass 6.
  - VI. Claim 19, drawn to a method of treating a disease comprising the administration of a polypeptide, classified in class 514, subclass 2.
  - VII. Claim 20, drawn to a method of screening a compound for effectiveness as an agonist, classified in class 436, subclass 500.
  - VIII. Claim 21, drawn to a composition which functions as an agonist, classified in class 514, subclass 2.
  - IX. Claim 22, drawn to a method of treating a disease comprising the administration of an agonist, classified in class 514, subclass 2.

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- X. Claim 23, drawn to a method of screening a compound for effectiveness as an antagonist, classified in class 436, subclass 500.
- XI. Claim 24, drawn to a composition which functions as an antagonist, classified in class 514, subclass 2.
- XII. Claim 25, drawn to a method of treating a disease comprising the administration of an antagonist, classified in class 514, subclass 2.
- XIII. Claim 26, drawn to a method of screening a compound that binds to a polypeptide of group I, classified in class 436, subclass 500.
- XIV. Claim 27, drawn to a method of screening a compound for its ability to modulate the activity of a polypeptide of group I, classified in class 436, subclass 500.
- XV. Claim 28 , drawn to a method of screening a compound for its ability to alter expression of a target polynucleotide, classified in class 435, subclass 6.
- XVI. Claim 29, drawn to a method of assessing toxicity of a test compound comprising the use of a polynucleotide, classified in class 435, subclass 6.
- XVII. Claims 30,33,35, and 44, drawn to a diagnostic test with an antibody, classified in class 436, subclass 513.
- XVIII. Claim 36, drawn to a method of preparing a polyclonal antibody, classified in class 435, subclass 71.1.
- XIX. Claim 39, drawn to a method of preparing a monoclonal antibody, classified in class 435, subclass 71.1.

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XX. Claim 45, drawn to a method of purifying a polypeptide with an antibody, classified in class 530, subclass 413.

The inventions are distinct, each from the other because of the following reasons:

2. The inventions of groups I, II, IV, VIII, and XI differ one from the other because the products of groups I, II, IV, VIII, and XI have different chemical properties, have different structures, have different functions, and are used for different purposes.
3. The inventions of groups III, V-VII, IX-X, and XII-XX differ one from the other because the products of groups III, V-VII, IX-X, and XII-XX have different methodological steps, have different outcomes, have different purposes, and use different reagents or biological compounds or materials.
4. Inventions I,II, IV, VIII, XI and V-VII,IX-X, XII-XVII, and XX are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the products of group I, II, IV, VIII, and XI can be used as biological analytical tools for in vitro analysis and experimentation.
5. Inventions III, XVIII, XIX and I, IV are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different

process (MPEP § 806.05(f)). In the instant case the products can be made by a materially distinct process such as through recombinant procedures.

6. Because these inventions are distinct for the reasons given above and the search required for the different groups are not required one for the other, they do not overlap nor are they co-extensive therefore, restriction for examination purposes as indicated is proper.

7. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher H Yaen whose telephone number is 703-305-3586. The examiner can normally be reached on Monday-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa can be reached on 703-308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are 703-

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308-4242 for regular communications and 703-305-3014 for After Final  
communications.

Any inquiry of a general nature or relating to the status of this application or  
proceeding should be directed to the receptionist whose telephone number is 703-308-  
0196.

Christopher Yaen  
Art Unit 1642  
September 17, 2002

*Brenda Brumback*  
**BRENDA BRUMBACK**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 1600**